

REMARKS**I. General**

Claims 1-4 and 6-21 are pending, and claims 1-4, 6, and 8-21 are rejected. Claims 1 and 18 are amended by this response. The issues in the Office Action mailed September 2, 2004 are as follows:

- Claims 1-4, 6, 15-19, 20 and 21 are rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent 5,734,372 (hereinafter, *Verstockt*) in view of U.S. Patent 6,486,873 (hereinafter, *McDonough*).
- Claims 8 and 9 are rejected under 35 U.S.C. §103 as being unpatentable over *Verstockt* in view of *McDonough* in further view of U.S. Patent 3,938,138 (hereinafter, *Kojima*).
- Claims 10, 11, 13, and 14 are rejected under 35 U.S.C. §103 as being unpatentable over *Verstockt* in view of *McDonough* in further view of U.S. Patent 6,559,830 (hereinafter, *Hinckley*).
- Claim 12 is rejected under 35 U.S.C. §103 as being unpatentable over *Verstockt* in view of *McDonough* in further view of U.S. Patent 6,650,322 (hereinafter, *Dai*).
- Claim 7 is objected to as being dependent on a rejected base claim, but is otherwise indicated as allowable.

Applicant hereby traverses the outstanding rejections and requests reconsideration and withdrawal in light of the remarks contained herein.

II. Amendments to the Claims

Claim 1 is amended in line 8 to change an occurrence of “a” to “an.” This amendment is merely to correct a typographical error, and no new matter is added. This amendment is not in response to any art, nor does it narrow the scope of claim 1.

Claim 18 is amended in line 6 to include the word “mode.” This amendment is merely to correct a typographical error, and no new matter is added. This amendment is not in response to any art, nor does it narrow the scope of claim 18.

III. Claim Objections

On page 7, the Office Action objects to claim 7 as depending from a rejected base claim, but otherwise indicates that claim 7 is allowable. Applicant thanks the Examiner for this indication of allowable subject matter. As explained below, Applicant believes that independent claim 1 is allowable. Accordingly, Applicant requests withdrawal of the objection to dependent claim 7.

IV. Claim Rejections

A. Rejections over *Verstockt* in view of *McDonough*

On pages 2-4, the Office Action rejects claims 1-4, 6, 15-19, 20 and 21 under 35 U.S.C. §103 as being unpatentable over *Verstockt* in view of *McDonough*. Applicant traverses the rejection.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the applied reference. Second, there must be a reasonable expectation of success. Finally, the applied reference must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143. Without conceding any other criteria, Applicants respectfully assert that the rejection does not satisfy the third criterion, as discussed further below.

1. Claims 1-4, 6, and 15-17

Claim 1 recites, in part, “said first illumination apparatus generating light when the computer-pointing device is in a standby mode.” The cited combination does not teach or suggest at least this feature of claim 1 because neither *Verstockt* nor *McDonough* teaches a standby mode of a computer-pointing device. First, *Verstockt* does not teach the above-mentioned feature. The Office Action cites Col. 3, lines 23-42 as teaching the feature;

however, that assertion is incorrect. The cited passage teaches that LEDs may be used for “noticing the operation status to the user.” *Verstockt* does not teach that the operation status is a standby mode, however. The operation status that *Verstockt* teaches is one that depends on a cumulative distance the cursor is moved on a screen or on a cumulative time that the mouse has been in operation. See Col. 2, line 54 through Col. 3, line 5. This cumulative operation status is used to determine when it is appropriate for a user to take a rest. See Col. 3, lines 14-17. Cumulative operation and movement is not the same as a standby mode. Thus, *Verstockt* does not teach or suggest the above-mentioned feature of claim 1.

Second, *McDonough* also does not teach the above-mentioned feature because *McDonough* does not teach a standby mode of a computer-pointing device. In at least one passage, *McDonough* teaches a status of a computer, not a standby mode of a computer-pointing device. See Col. 2, line 64 through Col. 3, line 3 of *McDonough*. Further, the Office Action cites Col. 7, lines 24-44 of *McDonough* as teaching different states of a computer-pointing device. Without conceding that the Office Action’s assertion is correct, it should be noted that *McDonough* does not teach a standby mode of a computer-pointing device. The cited passage from *McDonough* recites, in part, “In one arrangement, as shown in FIG. 6, the computer processing unit 310 may be coupled to a track-mouse control program 330 to control the ‘state’ or ‘states’ of one or more illumination devices 14 on the track-mouse device 10.” Col. 7, lines 24-27. The states of an illumination device are not the same as a standby mode of a computer-pointing device. Thus, *McDonough* fails to teach the feature because it does not teach a standby mode of a computer-pointing device. Therefore, the cited combination of *Verstockt* and *McDonough* does not teach or suggest the above-recited feature of claim 1.

Dependent claims 2-4, 6, and 15-17 each depend either directly or indirectly from independent claim 1 and, thus, inherit all of the limitations of independent claim 1. Thus, the cited combination does not teach or suggest all claim limitations of claims 2-4, 6, and 15-17. It is respectfully submitted that dependent claims 2-4, 6, and 15-17 are allowable at least because of their dependence from claim 1 for the reasons discussed above. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 1-4, 6, and 15-17.

2. Claims 18-19

Claim 18 recites, in part, “illuminating said first illumination apparatus if it is determined that the computer-pointing device is in the standby mode.” The cited combination does not teach or suggest this feature of claim 18 at least because neither *Verstockt* nor *McDonough* teaches a standby mode of a computer-pointing device. First, *Verstockt* does not teach the above-mentioned feature. The cited passage at Col. 3, lines 23-42 teaches that LEDs may be used for “noticing the operation status to the user.” *Verstockt* does not teach that the operation status is a standby mode, however. The operation status that *Verstockt* teaches is one that depends on a cumulative distance the cursor is moved on a screen or on a cumulative time that the mouse has been in operation. See Col. 2, line 54 through Col. 3, line 5. Cumulative operation and movement is not the same as a standby mode. Thus, *Verstockt* does not teach or suggest the above-mentioned feature of claim 18.

Second, *McDonough* also does not teach the above-mentioned feature because *McDonough* does not teach a standby mode of a computer-pointing device. In at least one passage, *McDonough* teaches a status of a computer, not a standby mode of a computer-pointing device. See Col. 2, line 64 through Col. 3, line 3 of *McDonough*. Further, the Office Action cites Col. 7, lines 24-44 of *McDonough* as teaching different states of a computer-pointing device. Without conceding that the Office Action’s assertion is correct, it should be noted that *McDonough* does not teach a standby mode of a computer-pointing device. The cited passage from *McDonough* recites, in part, “In one arrangement, as shown in FIG. 6, the computer processing unit 310 may be coupled to a track-mouse control program 330 to control the ‘state’ or ‘states’ of one or more illumination devices 14 on the track-mouse device 10.” Col. 7, lines 24-27. The states of an illumination device are not the same as a standby mode of a computer-pointing device. Thus, *McDonough* fails to teach the feature because it does not teach a standby mode of a computer-pointing device. Therefore, the cited combination of *Verstockt* and *McDonough* does not teach or suggest the above-recited feature of claim 18.

Dependent claim 19 depends from independent claim 18 and, thus, inherits all of the limitations of independent claim 18. Thus, the cited combination does not teach or suggest all claim limitations of claim 19. It is respectfully submitted that dependent claim 19 is

allowable at least because of its dependence from claim 18 for the reasons discussed above. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 18 and 19.

3. Claim 20

Claim 20 recites, in part, “means for providing for a user a first visual indication that the computer-pointing device is in a standby mode.” The cited combination does not teach or suggest at least this feature of claim 20 because neither *Verstockt* nor *McDonough* teaches a standby mode of a computer-pointing device. First, *Verstockt* does not teach the above-mentioned feature. The cited passage at Col. 3, lines 23-42 teaches that LEDs may be used for “noticing the operation status to the user.” *Verstockt* does not teach that the operation status is a standby mode, however. The operation status that *Verstockt* teaches is one that depends on a cumulative distance the cursor is moved on a screen or on a cumulative time that the mouse has been in operation. See Col. 2, line 54 through Col. 3, line 5. Cumulative operation and movement is not the same as a standby mode. Thus, *Verstockt* does not teach or suggest the above-mentioned feature of claim 20.

Second, *McDonough* also does not teach the above-mentioned feature because *McDonough* does not teach a standby mode of a computer-pointing device. In at least one passage, *McDonough* teaches a status of a computer, not a standby mode of a computer-pointing device. See Col. 2, line 64 through Col. 3, line 3 of *McDonough*. Further, the Office Action cites Col. 7, lines 24-44 of *McDonough* as teaching different states of a computer-pointing device. Without conceding that the Office Action’s assertion is correct, it should be noted that *McDonough* does not teach a standby mode of a computer-pointing device. The cited passage from *McDonough* recites, in part, “In one arrangement, as shown in FIG. 6, the computer processing unit 310 may be coupled to a track-mouse control program 330 to control the ‘state’ or ‘states’ of one or more illumination devices 14 on the track-mouse device 10.” Col. 7, lines 24-27. The states of an illumination device are not the same as a standby mode of a computer-pointing device. Thus, *McDonough* fails to teach the feature because it does not teach a standby mode of a computer-pointing device. Therefore, the cited combination of *Verstockt* and *McDonough* does not teach or suggest the above-recited feature of claim 20. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 20.

4. Claim 21

Claim 21 recites, in part, “said first illumination apparatus generating light when the computer-pointing device is in a standby mode.” The cited combination does not teach or suggest at least this feature of claim 21 at least because neither *Verstockt* nor *McDonough* teaches a standby mode of a computer-pointing device. First, *Verstockt* does not teach the above-mentioned feature. The cited passage at Col. 3, lines 23-42 teaches that LEDs may be used for “noticing the operation status to the user.” *Verstockt* does not teach that the operation status is a standby mode, though. The operation status that *Verstockt* teaches is one that depends on a cumulative distance the cursor is moved on a screen or on a cumulative time that the mouse has been in operation. See Col. 2, line 54 through Col. 3, line 5. Cumulative operation and movement is not the same as a standby mode. Thus, *Verstockt* does not teach or suggest the above-mentioned feature of claim 21.

Second, *McDonough* also does not teach the above-mentioned feature because *McDonough* does not teach a standby mode of a computer-pointing device. In at least one passage, *McDonough* teaches a status of a computer, not a standby mode of a computer-pointing device. See Col. 2, line 64 through Col. 3, line 3 of *McDonough*. Further, the Office Action cites Col. 7, lines 24-44 of *McDonough* as teaching different states of a computer-pointing device. Without conceding that the Office Action’s assertion is correct, it should be noted that *McDonough* does not teach a standby mode of a computer-pointing device. The cited passage from *McDonough* recites, in part, “In one arrangement, as shown in FIG. 6, the computer processing unit 310 may be coupled to a track-mouse control program 330 to control the ‘state’ or ‘states’ of one or more illumination devices 14 on the track-mouse device 10.” Col. 7, lines 24-27. The states of an illumination device are not the same as a standby mode of a computer-pointing device. Thus, *McDonough* fails to teach the feature because it does not teach a standby mode of a computer-pointing device. Therefore, the cited combination of *Verstockt* and *McDonough* does not teach or suggest the above-recited feature of claim 21. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 21.

B. Rejections over *Verstockt* in view of *McDonough* in further view of *Kojima*

At pages 4-5, the Office Action rejects claims 8 and 9 under 35 U.S.C. §103 as being unpatentable over *Verstockt* in view of *McDonough* in further view of *Kojima*. Applicant traverses the rejection.

Dependent claims 8 and 9 each depend from independent claim 1 and, thus, inherit all of the limitations of independent claim 1. As shown above, the combination of *Verstockt* and *McDonough* does not teach or suggest each and every feature of claim 1. The Office Action does not rely on *Kojima* to cure the deficiency. Thus, the cited combination does not teach or suggest all claim limitations of claims 8 and 9. It is respectfully submitted that dependent claims 8 and 9 are allowable at least because of their dependence from claim 1 for the reasons discussed above. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 8 and 9.

C. Rejections over *Verstockt* in view of *McDonough* in further view of *Kojima*

At pages 5-6, the Office Action rejects claims 10, 11, 13, and 14 under 35 U.S.C. §103 as being unpatentable over *Verstockt* in view of *McDonough* in further view of *Hinckley*. Applicant traverses the rejection.

Dependent claims 10, 11, 13, and 14 each depend from independent claim 1 and, thus, inherit all of the limitations of independent claim 1. As shown above, the combination of *Verstockt* and *McDonough* does not teach or suggest each and every feature of claim 1. The Office Action does not rely on *Hinckley* to cure the deficiency. Thus, the cited combination does not teach or suggest all claim limitations of claims 10, 11, 13, and 14. It is respectfully submitted that dependent claims 10, 11, 13, and 14 are allowable at least because of their dependence from claim 1 for the reasons discussed above. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 10, 11, 13, and 14.

D. Rejections over *Verstockt* in view of *McDonough* in further view of *Dai*

At pages 6-7, the Office Action rejects claim 12 under 35 U.S.C. §103 as being unpatentable over *Verstockt* in view of *McDonough* in further view of *Dai*. Applicant traverses the rejection.

Dependent claim 12 depends from independent claim 1 and, thus, inherits all of the limitations of independent claim 1. As shown above, the combination of *Verstockt* and *McDonough* does not teach or suggest each and every feature of claim 1. The Office Action does not rely on *Dai* to cure the deficiency. Thus, the cited combination does not teach or suggest all claim limitations of claim 12. It is respectfully submitted that dependent claim 12 is allowable at least because of its dependence from claim 1 for the reasons discussed above. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 12.

V. Conclusion

In view of the above response, Applicant believes the pending application is in condition for allowance.

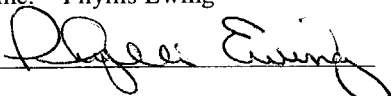
Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10003357-1 from which the undersigned is authorized to draw.

Dated: December 2, 2004

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Airbill No. EV482739975US in an envelope addressed to: MS Amendment, Commissioner for Patents, Alexandria, VA 22313-1450.

Date of Deposit: December 2, 2004

Typed Name: Phyllis Ewing

Signature: 

Respectfully submitted,

By: 

Michael A. Papalas
Reg. No. 40,381
Attorney for Applicant

(214) 855-8186